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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/930,601 | 08/14/2001 | Mark Manuel | 199-003 | 1765 |

7590 06/11/2003

Law Offices of John Chupa and Associates, P.C.
28535 Orchard Lake Road
Suite 50
Farmington Hills, MI 48334

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| EXAMINER |
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HECKENBERG JR, DONALD H

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| ART UNIT | PAPER NUMBER |
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1722

DATE MAILED: 06/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930,601

Applicant(s)

MANUEL, MARK

Examiner

Donald Heckenberg

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 19-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-18 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Applicant's election of Group I (claims 1-18) in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 19-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected process, there being no allowable generic or linking claim.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Bak et al. (U.S. Pat. App. Pub. 2002/0175265).

Bak discloses a molding tool with cooling passages. As shown in figures 6A & 6B, the tool comprises first and second

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sectional members (B1 and B2) which are coupled together to form the tool (see figure 6A). The first and second members have identical first and second indented channels aligned with one another to form cooling passages (C1, C2, and C3). Bak further discloses a configuration of the apparatus wherein the cooling channels terminate with the tool (see figures 9A and 9B and ¶ 85, lines 1-6).

It is noted that claims 6-11 are in product by process format. The determination of patentability in product by process claims is based on the product itself. The patentability of a product does not depend on its method of production. In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); In re Brown, 459 F.2d 531, 173 USPQ 685 (Cust. & Pat. App. 1972); In re Pilkington, 411 F.2d 1345, 162 USPQ 145 (Cust. & Pat. App. 1969); see also MPEP § 2113. In the instant case, as described above Bak discloses a tool with all of the structural features recited in the claims of the instant application. Accordingly, Bak anticipates the product of process claims of the instant application.

4. Claims 12 and 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Vandergrift (U.S. Pat. No. 1,539,887).

Vandergrift discloses a molding tool. The molding tool comprises a first member (2) and a second member (3). A spacer member (7) is coupled to the first and second members to form a cooling passage (8). The spacer member has a rectangular cross sectional area (see figure 3), and it is evident from the scale shown in figures 1-2 that the spacer of Vandergrift has a thickness of greater than 0.001 inches.

As noted above in the rejection of claims under 102(e) anticipation by Bak, the determination of patentability in product by process claims is based on the product itself. As Vandergrift discloses all of the product-structural limitations of claims 15-18, the reference anticipates these claims.

5. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Miller (U.S. Pat. No. 3,416,766).

Miller discloses a molding tool. As shown in figure 2, the tool comprises a first member (5) having at least one groove therein. The tool further comprises a sectioned member (4) which is coupled to the first member. The sectioned member has flat face which overlays the groove thereby forming a cooling passage (6 and 7).

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6. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest a tool comprising a first member, a second member, and at least one spacer member which cooperates with the first and second member to form a tool having a cooling passage, wherein the spacer is attached to the first member by a first welded connection and wherein the spacer is attached to the second member by a second welded connection as recited in claim 13.

The closest prior art is described above. None of the references of record disclose, or suggest the combination of claim 13 with the welded connections between the first and second members and the spacer member.


8. The following reference is cited as pertinent to the instant invention:


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Strausfled (U.S. Pat. No. 4,141,531) discloses a tool with a cooling passage formed by two members.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for responses to non-final action, and 703-872-9311 for responses to final actions. The unofficial fax phone number is (703) 305-3602.


Donald Heckenberg
June 9, 2003


JAMES P. MACKEY
PRIMARY EXAMINER
6/10/03